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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/311,928	05/14/1999	SAMIR H. NANAVATI	2709/IBG	1907

26304 7590 04/23/2004

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EXAMINER

WRIGHT, NORMAN M

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 04/23/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/311,928

Applicant(s)

NANAVATI ET AL.

Examiner

Norman M. Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-14 and 19 is/are rejected.
- 7) ☒ Claim(s) 9 and 16-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or

NORMAN M. WRIGHT
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings filed are acceptable for examination purposes only, see correction of the informalities indicated on the previously attached "Notice of Draftsperson's Patent Drawing Review," PTO-948, paper number 5.

Response to Amendment

1. The declaration filed on 1/6/04 under 37 CFR 1.131 has been considered but is ineffective to overcome the U.S. Pat. No. 6,484,260 reference.
2. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Scott et al., U.S. Pat. No. 6,484,260 reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). There has been no evidence showing that the declaration has established the claimed invention as a whole or in part in which the claims reads on it. Nor has the declaration shown evidence, that the declaration has established the scope of the reference invention of Smith '260 as a whole or in part which reads on it.
3. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date

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of the Smith '260 reference. Applicant has not provided evidence of the actual dates of acts relied upon to establish such a conception of the invention prior to the reference.

4. Nor is a general allegation that the invention was completed prior to the date of the reference is sufficient. Further information on Facts and Documentary Evidence may be found in MPEP 715.07.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-27 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Scott et al., U.S. Pat. No. 6,484,260, hereinafter '260.

7. As to claims 1-5, and 7-15, '260 substantially teaches the claimed invention comprising a method of verifying the identity, generating a first message, transmitting a unique message, issuing a second message, providing verification, and issuing the results, a sender/receiver 26/28/38, posting to a central biometric authority/host or trusted third party, capability to process a plurality of biometrics systems, centralized enrollment and registration, and a central biometric authority/host or proxy/trusted third party/39, having submission profiles/templates. Information about the system used to

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capture biometric/device information, synch encryption, not disclosing biometric

samples/ signals representative exchanged not samples, successful verification/key.

See '260 at figs. 1-3, 7-8, summary, col. 1, lines 46 et seq., col. 2, lines 15-40 et seq.,

col. 3, lines 5 et seq., col. 10-11 et seq., col. 6, lines 28-68 et seq., and cols. 7, lines 1 et

seq., col. 1, lines 20-28 et seq., col. 4, lines 43 et seq.,

8. As to claim 6, the system may be utilized via a plurality of different devices and systems, which in turn use may use biometric traits as a means of authentication the users or devices; as such, the systems provide a verification signal/standard that is recognizable by the host and portable identification devices (col. 5, lines 1- col. 6 et seq.).

9. As claims 16-27, they recite similar subject matter which is included in the above rejection of claims 1-15. Accordingly, they are rejected upon the same rationale as recited above.

Allowable Subject Matter

10. The indicated allowability of claims 9 and 15-18 is withdrawn in view of further consideration of the '260 reference and a clearer understanding of the breadth of applicant's claim. The device information of the portable devices is believed to encompass the scope of the language used in the claims for how the samples were captured. Additionally, the authorized transactor is the broadly viewed as user verification information that has already been linked to a plurality of users, meaning that it is the verification message that a user is authorized registered and authenticated user. The indication of previous allowability is regretted.

Response to Arguments

11. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to Norman M. Wright at telephone number (703) 305-9586.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norman M. Wright whose telephone number is (703) 305-9586. The examiner can normally be reached on Mondays from 8am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse, can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


**NORMAN M. WRIGHT
PRIMARY EXAMINER**